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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,645	02/20/2004	Takahiro Goto	Q79923	2125

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT PAPER NUMBER

1752

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/781,645

Applicant(s)

GOTO, TAKAHIRO

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/14/2005 & 7/18/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/14/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed July 18, 2005 has been fully considered.
2. Claims 1-18 are present in the application. The amendment is fully supported by the specification.

***Information Disclosure Statement***

3. The corrected IDS submitted September 14, 2005 has been fully considered.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (EP 1 223 196 A2).

- a. The negative image-recording material of Nakamura et al., used to make a printing plate, comprises a cyanine IR absorbent, a radical generator, a radically polymerizable compound and polymer binder (abstract; [0088]-[0096], claims 1 and 29). The IR absorbents of formula (3), (3-1), IR-1, IR-2, and IR-5 anticipate the presently claimed infrared absorbing compound (claims 3, 6-8, 12, 14). A sulfonium salt

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is among the preferred radical generators and is represented by general formula (V) (claims 15-20; [0066]-[0069]). In general formula (V), R<sub>31</sub>, R<sub>32</sub> and R<sub>33</sub> are optionally substituted hydrocarbon groups having at most 20 carbon atoms. Examples of substituents include halogen atoms. Nakamura et al. do not exemplify a sulfonium salt having three aryl groups two of which are substituted specifically with chlorine atoms however it would have been obvious to one of ordinary skill in the art to incorporate any halogen substituent including chlorine atoms. Especially preferred supports of the image forming material are aluminum supports having a center line average roughness between 0.1 and 1.2  $\mu\text{m}$  ([0116]-[0127]).

6. Claims 7-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (EP 1 223 196 A2) as applied to claims 1-3 above, and further in view of Oshima (EP 1 176 467 A1).

a. As indicated in the previous rejection, Nakamura et al. teaches a negative image-recording material, used to make a printing plate, wherein the negative image-recording material comprises a cyanine IR absorbent, a radical generator, a radically polymerizable compound and polymer binder (abstract; [0088]-[0096], claims 1 and 29). In Nakamura et al., a sulfonium salt is among the preferred radical generators and is represented by general formula (V). Other preferred radical generators include iodonium salts and diazonium salts, which can be used alone or in combination of two or more (claims 15-20; [0066]-[0072]). Linear organic polymers, soluble or swellable in water or weakly alkaline water, are preferred as the binder polymer ([0088]). Nakamura et al. does not teach the binder polymer required in the present application.

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However, based on the teachings of Oshima, it would have been obvious to incorporate the linear organic high-molecular polymer containing repeating units represented by formula (I) in order to obtain a lithographic printing plate having high printing durability ([0009]-[0013]).

### ***Response to Arguments***

7. Applicant's arguments filed July 18, 2005 have been fully considered but they are not persuasive.

a. Applicant argued that Oshima discloses neither the specific cyanine dye nor the specific triarylsulfonium salt. The Examiner agrees. However as noted in the art rejections, Nakamura et al. teaches the specific cyanine dye required in the present application and the required triarylsulfonium salt would have been obvious from the teachings of Nakamura et al.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Barbara L. Gilliam*

Barbara L. Gilliam  
Primary Examiner

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October 13, 2005